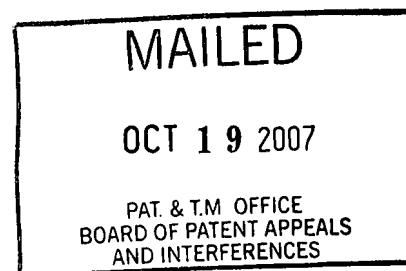


1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
4
5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
9

10 Ex parte JEFFERY N. EISEN
11

12
13 Appeal 2007-2514
14 Application 10/034,255
15 Technology Center 2100
16
17



18 Oral Hearing Held: September 12, 2007
19
20
21

22 Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and
23 ST. JOHN COURTENAY III, Administrative Patent Judges
24

25 ON BEHALF OF THE APPELLANT:
26

27 SYED ALI, ESQUIRE
28 Pillsbury, Winthro, Shaw, Pittman, LLP
29 P.O. Box 10500
30 McLean, Virginia 22102
31

32 The above-entitled matter came on for hearing on Wednesday,
33 September 12, 2007, commencing at 9:52 a.m., at The U.S. Patent and
34 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Laurel P.
35 Platt, RDR, CCR No. 0313203, Notary Public.
36
37

1 THE CLERK: Appeal number 2007-2514, and the attorney is Syed
2 Ali.

3 JUDGE GROSS: You can begin whenever you want.

4 MR. ALI: Okay. This will probably be brief. I probably won't even
5 need a full 20 minutes. I just want to address a couple of points that the
6 examiner raises, and after that I will be glad to answer any questions you
7 may have.

8 At first we'd like to just touch briefly on the 112 objections alleging
9 indefiniteness. Specifically, the examiner seems to allege that our claim
10 language in the various claims which describes properties of our reusable list
11 as being able to be pasted into one of our documents is indefinite because it
12 may or may not describe functionality.

13 The thing about this is that we feel this is kind of clear and
14 unambiguous on its face, and we are just pretty much describing properties
15 and characteristics of the list, which is standard practice.

16 Really, what we are trying to get after here is functionality of our
17 software which is sort of different from getting into actually whether or not
18 the list is pasted, which is user functionality or user activity which is not a
19 function of the software itself.

20 But if you look at the claim language itself, it's pretty clear I think
21 what the properties and characteristics of the list are and what the boundaries
22 of the claim are.

23 That's all I have for that.

24 Secondly, in regards to the 103 objections, we'd like to focus on the
25 examiner's rationale for making this rejection. Several of the principles that
26 he uses in his rationale specifically contradict express features of our claim.

1 For example, the examiner continues to go on and say that the
2 combination will be obvious because copying and pasting would protect and
3 preserve original files attached to an e-mail.

4 By contrast, our claim specifically recites that the usable list includes
5 hyperlinks to the actual document associated with the entry, not a copy of
6 the document.

7 In other words, the list includes hyperlinks to live versions of the
8 document. So when somebody goes in, accesses the document and makes
9 changes and it's subsequently accessed, the subsequently accessed document
10 will include any changes that were made.

11 Copying and pasting are kind of a different thing in the sense of the
12 original document is untouched and whatever is manipulated in the copy
13 version, those changes won't be reflected in the original.

14 And the examiner's rationale is pretty clear in that he's looking at
15 traditional copy-and-paste functionality, that it doesn't create that hyperlink
16 to the live document he's using. He shows that e-mail being pasted into a
17 document.

18 Another thing we'd like to point out is that object that is pasted into
19 the document is not a hyperlink to the e-mail. At best it's maybe an object
20 that represents the original e-mail, but it's not actually a hyperlink to that live
21 document.

22 So even though he may include similar data as to what was in that e-
23 mail, when you open it and access it, it's the e-mail as of when it was pasted,
24 not a hyperlink to the document, which is what we are claiming. Based on
25 that, we think it's pretty clear that the traditional copy-and-paste
26 functionality is not doing what we are claiming.

1 That's all I have to say. May I answer your questions?

2 JUDGE GROSS: I have some questions.

3 MR. ALI: Sure.

4 JUDGE GROSS: First of all, your claims, say, explain the summary
5 view of one or more entries. So that means it could be a single entry; right?

6 MR. ALI: Sure.

7 JUDGE GROSS: And you could select a single entry, create a list of
8 a single entry, more than one; but if there's only one, then your list would
9 only include one.

10 MR. ALI: Right.

11 JUDGE GROSS: Given that, in planning, they talk about being able
12 to manipulate files and folders. They seem to manipulate all kinds of things.

13 And a lot of their -- for lack of a better word -- embodiments have to
14 do with lists that are shown as including descriptions and some sort of link.
15 Granted, it doesn't necessarily say a hyperlink, but a link to further
16 information about that entry in the list. Do you agree so far?

17 MR. ALI: For the most part. I think that that distinction between not
18 having specific hyperlinks is important. It shouldn't be overlooked. Other
19 than that.

20 JUDGE GROSS: Just want to make sure. Okay.

21 So one of the things that they say, for example -- well, if you look at
22 Figure 2C, and the description is on page 4, that's paragraph 64. It says that
23 the desktop displays short descriptions of the to-do items and their due dates.
24 Can also include links that the user can activate to retrieve additional
25 information pertaining to the particular to-do item.

26 This has to do with a to-do list which seems to update itself, if you

1 look in the next few paragraphs. It talks about expired items can be removed
2 or discarded. A lot of it seems to be automated.

3 It doesn't explicitly say that it updates that link. I agree that it doesn't
4 explicitly say that.

5 It also says, let's see, if you go to different embodiment, it talks about
6 files. And it says that the user can -- look at page 10, paragraph 127. Files
7 and folders can be displayed using various formats including icons, listings,
8 combinations, et cetera. And it says -- the next paragraph -- the user can
9 create a duplicate of the selected item, make a copy of the selected item into
10 another folder and so on.

11 Given that, given all the teachings as a whole and particularly in view
12 of the case law, would you agree that it would have been obvious to copy an
13 item, right? Repeat, it doesn't say anything about a hyperlink per se. But an
14 item, say, from Figure 2C with the description and the link to, say, another
15 folder or to another --

16 MR. ALI: Not particularly. I mean something we have to look at
17 here, this to-do list, I think it is kind of a different object than what the
18 examiner is relying on.

19 JUDGE GROSS: Well, then go the other way. In view of all the
20 teachings, would it have been obvious for the file or folder, the list of files or
21 folders to include descriptions like this does, you know, like the to-do list
22 does, and maybe even links, and to copy one from one to another folder, for
23 example?

24 MR. ALI: No, I don't think so. I mean, really, to get back to the to-do
25 list, suppose you have the topic and the description. You could say that
26 that's an entry with a summary view. But I don't think that you can really

1 copy and paste this in a way that leans on the claim language.

2 What we are talking about is not really -- it's the document underlying
3 the hyperlink. This is -- the hyperlink itself, and this, you know, I guess,
4 column 252 in Figure 2C, that would have to be the item, though that would
5 have to be the item that would be copied and pasted.

6 Really, what it seems to me more likely to be is what the examiner is
7 relying upon would be the to-do list itself.

8 JUDGE GROSS: I'm not talking about what the examiner is relying
9 on. We are going a different way here.

10 MR. ALI: Okay. Fair enough.

11 The thing is that there's no document underlying this hyperlink. For
12 example, I don't think that Longgood teaches a way of taking those items in
13 that list and copying them into other documents, let alone to have them in a
14 way that's a live version of what is underlying that object.

15 I went through this reference pretty closely, and I didn't see anything
16 that would suggest that.

17 I mean, for example, paragraph 10 at 128, that's what you are talking
18 about in terms of copying, the last sentence.

19 For example, to make a duplicate of the selected item, make a copy of
20 the selected item into another folder, it's explicitly saying it's a copy. It's a
21 duplicate. It's not a link to that entry.

22 Our claim language specifically says that the reasonable list includes .
23 . . not a copy of the document. So on its face, it's not reading the claim
24 language because it's copy.

25 JUDGE COURTENAY: I notice in looking at your presentation, you
26 probably spoke of the document as including a message file or other unit of

1 information. So a document is really just any kind of information that you're
2 claiming; is that correct?

3 MR. ALI: Sure.

4 JUDGE RUGGIERO: Thank you.

5 MR. ALI: Thank you.

6 (Whereupon, at 10:03 a.m. the proceedings were concluded.)